

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

LUCKY BREAK WISHBONE
CORPORATION,

Plaintiff,

v.

SEARS, ROEBUCK AND CO., a New York
corporation, and YOUNG AND RUBICAM
INC., a Delaware corporation,

Defendants.

No. C06-312Z

ORDER

This matter comes before the Court on Defendant Sears, Roebuck and Co.'s Motion to Strike the Hillesland Declaration, docket no. 159, at 3-4, and Plaintiff's Motion for Reconsideration of Court's Order of 12/18/07, docket no. 154. Having considered the briefs and declarations in support of and in opposition to the motions, the Court DENIES Defendant Sears, Roebuck and Co.'s Motion to Strike the Hillesland Declaration, docket no. 159, at 3-4, and GRANTS IN PART and DENIES IN PART Plaintiff's Motion for Reconsideration of Court's Order of 12/18/07, docket no. 154.

1 **I. Defendant Sears, Roebuck and Co.’s Motion to Strike the Hillesland Declaration,**
 2 **docket no. 159, at 3-4**

3 Defendant Sears argues that Mr. Hillesland’s recent declaration, signed January 4,
 4 2008, is akin to a “sham affidavit” submitted to create issues of fact in avoidance of
 5 summary judgment. See Hambleton Bros. Lumber Co. v. Balkin Enters., Inc., 397 F.3d
 6 1217, 1225 (9th Cir. 2005) (“Under our ‘sham’ affidavit rule, ‘a party cannot create an issue
 7 of fact by an affidavit contradicting his prior deposition testimony.’) (quoting Kennedy v.
 8 Allied Mut. Ins. Co., 952 F.2d 262, 266 (9th Cir. 1991)).

9 When Mr. Hillesland was asked at his deposition, “So how did you – did you have the
 10 prototype *mold* in front of you when you made the changes to the graphite on the production
 11 mold,” he answered, “I don’t remember.” Rachman Decl., docket no. 160, Ex. 1 (Hillesland
 12 Dep.) at 42:8-11 (emphasis added). In Mr. Hillesland’s recent declaration, he stated:

13
 14 I do not specifically remember whether I had the prototype *mold* in front of me
 15 when I was making changes to the graphite electrodes used for making the
 16 production wishbone mold. It is likely that I did not have the *mold* in front of
 17 me at that time, because it was probably with Lucky Break’s factory, being
 18 used to make wishbones. However, when I was making the manual alterations
 to the graphite electrodes used for the production mold, I absolutely had the
 prototype *electrodes* in front of me, and I did reference those prototype
electrodes to ensure that I was making the same manual alterations to those
 electrodes that I had made in producing the prototype wishbone mold.

19 Hillesland Decl., docket no. 157, ¶¶ 2-3 (emphasis added). Mr. Hillesland’s recent
 20 declaration statements are consistent with his deposition testimony relating to his failure to
 21 remember whether he directly referenced the prototype mold. At his deposition, he was only
 22 asked whether he had the prototype mold, not the prototype electrodes, in front of him when
 23 making manual alterations to the production electrodes. Defendant Sears argues that Mr.
 24 Hillesland should have testified at his deposition that he referenced the prototype electrodes
 25 in response to open-ended questions about his process for making the production wishbone.
 26 Because Mr. Hillesland was not specifically asked in his deposition whether he referenced

1 the prototype electrodes when making his manual alterations to the production electrodes, he
2 cannot be faulted for not having so testified. Accordingly, the Court DENIES Defendant
3 Sears, Roebuck and Co.'s Motion to Strike the Hillesland Declaration, docket no. 159, at 3-

4 **4. II. Plaintiff's Motion for Reconsideration of Court's Order of 12/18/07, docket no.**
5 **154**

6 **A. Standard for Motions for Reconsideration**

7 "Motions for reconsideration are disfavored. The Court will ordinarily deny such
8 motions in the absence of a showing of manifest error in the prior ruling or a showing of new
9 facts or legal authority which could not have been brought to its attention earlier with
10 reasonable diligence." Local Rule CR 7(h).

11 **B. Timeliness of Mr. Hillesland's Declaration, docket no. 157**

12 Lucky Break argues that it has discovered "new facts that realistically could not have
13 been brought to this Court's attention before now," specifically Mr. Hillesland's reference to
14 the prototype electrodes when making manual alterations to the production electrodes. Pl.'s
15 Mot. Reconsideration, docket no. 154, at 1. Defendant Sears responds that Mr. Hillesland's
16 recent declaration should not be considered new evidence because Lucky Break had several
17 opportunities to bring such evidence to the Court's attention.

18 In Defendants' summary judgment motion, Defendants argued that Lucky Break
19 failed to obtain a valid copyright registration in the prototype wishbone because Lucky Break
20 deposited a copy of the production wishbone, rather than the prototype wishbone, with its
21 copyright registration application in December 2005. Defs.' Mot. Summ. J., docket no. 87,
22 at 10-11. In response, Lucky Break did not argue that the deposit copy of the production
23 wishbone was a bona fide copy of the prototype wishbone, and that, as a result, Lucky
24 Break's registration of the prototype wishbone was valid. Instead, Lucky Break argued that
25 there is no difference in the design between Lucky Break's prototype and production
26 wishbones. Pl.'s Opp'n, docket no. 105, at 7-8.

1 The Court subsequently focused the parties on the “bona fide copy” issue and case
2 law, noted the implications on the Court’s jurisdiction, and requested supplemental briefing.
3 Order of Dec. 4, 2007, docket no. 140, at 13-14, 22 n.10; Minutes of Telephone Conference,
4 docket no. 144. Lucky Break should have submitted the evidence regarding Mr. Hillesland’s
5 reference to the prototype electrodes in connection with Lucky Break’s supplemental brief,
6 but did not do so. Pl.’s Suppl. Br., docket no. 145.

7 Now that the Court has ruled against Lucky Break and has concluded that it lacks
8 subject matter jurisdiction over Lucky Break’s wishbone copyright claim, see Order of
9 December 18, 2007, docket no. 151, Lucky Break submits the “new” evidence and argues in
10 its motion for reconsideration that “Lucky Break believed that it was not authorized to
11 submit evidence” in connection with the supplemental briefing. Pl.’s Mot. Reconsideration,
12 docket no. 154, at 2. Because there could have been some confusion as to whether new
13 evidence could be submitted in connection with the supplemental briefs, and because this is
14 such a crucial issue that the Court seeks to decide on the merits, the Court declines to reject
15 Mr. Hillesland’s recent declaration as untimely.

16 **C. Bona Fide Copy**

17 “[T]he registration deposit requirement permits ‘bona fide copies of the original work
18 only.’” Kodadek v. MTV Networks, Inc., 152 F.3d 1209, 1211 (9th Cir. 1998) (quoting
19 Seiler v. Lucasfilm, Ltd., 808 F.2d 1316, 1322 (9th Cir. 1986)). A “bona fide copy” of an
20 original work “must be virtually identical to the original *and* must have been produced by
21 directly referring to the original.” Id. at 1212 (emphasis added).

22 The Court must determine whether, in light of Mr. Hillesland’s recent declaration, the
23 Court should reconsider its prior conclusion that “the production wishbone deposit was not a
24 bona fide copy of the prototype wishbone.” Order of December 18, 2007, at 4. The Court
25 based this conclusion on “the absence of any evidence that Mr. Hillesland directly referred to
26 the prototype graphite electrodes, mold or wishbone when he created the production

1 wishbone mold.” Id. In other words, the Court based its “not a bona fide copy” conclusion
2 on the second prong of the bona fide copy test. Now, the following testimony from Mr.
3 Hillesland is before the Court: “[W]hen I was making the manual alterations to the graphite
4 electrodes used for the production wishbone mold, I absolutely had the prototype electrodes
5 in front of me, and I did reference those prototype electrodes to ensure that I was making the
6 same manual alterations to those electrodes that I had made in producing the prototype
7 wishbone mold.” Hillesland Decl., docket no. 157, ¶ 3. This evidence satisfies the second
8 prong of the “bona fide copy” test.¹ Accordingly, the Court GRANTS IN PART Plaintiff’s
9 Motion for Reconsideration, docket no. 154, and concludes that the second “directly refer”
10 prong of the bona fide copy test is met because Mr. Hillesland directly referred to the
11 prototype electrodes, which were used to make the prototype mold and the prototype
12 wishbone, when making the manual alterations to the production electrodes, which were
13 used to make the production mold and the production wishbone.

14 Next, Lucky Break asks the Court to conclude “that the existing deposit materials are
15 sufficient to support a valid copyright registration.” Pl.’s Mot. Reconsideration, docket no.
16 154, at 3. In order to determine whether the existing deposit materials are sufficient, the
17 Court must address the “virtually identical” issue – i.e., the first prong of the bona fide copy
18 test. In its Order of December 18, 2007, the Court noted that “[t]here are factual disputes as
19 to whether the prototype and production wishbones are ‘virtually identical.’” Order of Dec.
20 18, 2007, at 3. The Court then stated that it “does not reach this [virtually identical] issue
21 because Lucky Break has failed to provide any evidence that Mr. Hillesland produced the
22 production wishbone by directly referring to the prototype wishbone.” Id. Now that the
23 Court has reconsidered its conclusion regarding the “directly refer” prong of the bona fide
24 copy test, the Court must also reconsider its prior ruling in so far as the Court must reach the
25 issue of whether the prototype and production wishbones are “virtually identical.” To the

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¹ Defendant Sears does not argue otherwise. See Def.’s Opp’n, docket no. 159, at 5.

1 extent the Court is now reaching the “virtually identical” prong of the bona fide copy test,
2 the Court GRANTS IN PART Plaintiff’s Motion for Reconsideration, docket no. 154.

3 A threshold question arises as to whether a jury or the Court should determine the
4 “virtually identical” issue. “Where the parties dispute whether the deposit copy was bona
5 fide, or was an impermissible reconstruction, the district court should first determine whether
6 that question implicates the merits of the case. If it does not, the court should weigh the
7 evidence that is submitted and make a factual finding on the copy/reconstruction issue.”
8 Torres-Negrón v. J & N Records, LLC, 504 F.3d 151, 164 (1st Cir. 2007) (cited by Lucky
9 Break in a separate Motion for Reconsideration, docket no. 150, at 3-4). Because “the trial
10 court’s jurisdiction – its very power to hear the case”- is at issue, “there is substantial
11 authority that the trial court is free to weigh the evidence and satisfy itself as to the existence
12 of its power to hear the case.” Torres, 504 F.3d at 163; Lawrence v. Dunbar, 919 F.2d 1525,
13 1529 (11th Cir. 1990).

14 In the cross-motions for summary judgment and the supplemental briefs regarding the
15 Court’s jurisdiction filed in the present case, the parties dispute whether the prototype and
16 production wishbones are “virtually identical.” This jurisdictional question does not
17 implicate the merits of the case because the Court has already entered a ruling on creative
18 content and originality of the prototype wishbone, and has therefore taken the
19 copyrightability question away from the jury. Order of Dec. 4, 2007, at 15-20. Even if the
20 copyrightability issue remained for a jury determination at trial, that issue is independent of
21 the physical process by which the production wishbone was created. See Torres, 504 F.3d at
22 163. At trial, a jury will be asked to determine whether the Lucky Break prototype wishbone
23 and the Sears wishbone are virtually identical, see Order of Dec. 4, 2007, at 23-25, but not
24 whether the Lucky Break prototype and production wishbones are identical. As a result, the
25 Court is permitted to weigh the evidence and make a factual finding on the
26 copy/reconstruction issue. See Torres, 504 F.3d at 163-164.

1 It is undisputed that Lucky Break submitted a photocopy of its production wishbone
2 to the U.S. Copyright Office with its application to register a copyright of the prototype
3 wishbone, and did not submit a photocopy of the “original” prototype wishbone. See
4 Rachman Decl., docket no. 160, Ex. 2 at 15 (Transcript page 49) (Lucky Break’s counsel
5 stating that “we submitted a production wishbone to the copyright office as our deposit
6 material”).² It is also undisputed that the production wishbone was created using its own set
7 of graphite electrodes and mold, separate from the graphite electrodes and mold used to
8 create the prototype wishbone, and that Mr. Hillesland’s creative input occurred primarily
9 through his manual alterations of the graphite electrodes. See Order of Dec. 4, 2007, at 4-8.
10 When asked in his deposition “whether the hand changes [he] made on the production mold
11 [were] the same as the ones [he] made on the prototype mold,” Mr. Hillesland testified: “I
12 don’t know.” Rachman Decl., docket no. 160, Ex. 1 (Hillesland Dep.) at 42:12-15. He later
13 admitted in his deposition that there “could be variations” between the manual alterations
14 that he made to the graphite electrodes for the prototype mold as compared to the manual
15 alterations that he made to the graphite electrodes for the production mold. Id., Ex. 1
16 (Hillesland Dep.) at 48:11-19. The Court gives little weight to Mr. Hillesland’s subsequent
17 declaration statement, see Hillesland Decl., docket no. 108, ¶ 12, in which he states that he
18 “made the same manual alterations to the [production] electrodes,” because this statement
19 contradicts his prior deposition testimony. See Kennedy, 952 F.2d at 266. Mr. Hillesland
20 has consistently testified that there are resulting differences between the prototype and
21 production wishbones, including the thickness, the parting line, and the height of the ejector
22 pins. Id., Ex. 1 (Hillesland Dep.) at 40:4-41:11, 42:16-43:2, 49:8-10, 50:12-51:18;
23 Hillesland Decl., docket no. 108, ¶ 12.

24
25 ² Lucky Break appears to have wanted to register the prototype wishbone. The first page
26 of Lucky Break’s application to register a copyright states that “2004” was “the year in which
creation of this work was completed.” Ahroni Decl., docket no. 66, Ex. A. It is undisputed that
Mr. Hillesland created the prototype wishbone mold between December 2003 and January 2004,
and that he created the production wishbone mold between June 2005 and September 2005.

1 Although Mr. Hillesland has opined that the production wishbones were “effectively
2 identical” to the prototype wishbones, and that in his mind, “the prototype and production
3 Lucky Break Wishbones are the same wishbone sculpture,” these are conclusory statements
4 that are not entitled to much, if any, weight. Such statements fail to refute the facts, outlined
5 above, which demonstrate that the prototype and production wishbones are different
6 sculptural works, created nearly two years apart from different graphite electrodes and
7 molds, with admitted resulting differences. Accordingly, the Court DENIES IN PART
8 Plaintiff’s Motion for Reconsideration to the extent Lucky Break moved the Court to
9 conclude “that the existing deposit materials are sufficient to support a valid copyright
10 registration,” a conclusion that would have required the Court to find that the prototype and
11 production wishbones are virtually identical. The Court concludes that the prototype and
12 production wishbones are not “virtually identical” for the purposes of copyright registration.

13 **D. Conclusion**

14 The Court GRANTS IN PART and DENIES IN PART Plaintiff’s Motion for
15 Reconsideration of Court’s Order of 12/18/07, docket no. 154. The Court grants in part the
16 motion and concludes that the second “directly refer” prong of the bona fide copy test is met
17 because Mr. Hillesland directly referred to the prototype electrodes when making the manual
18 alterations to the production electrodes. The Court grants in part the motion and reaches the
19 “virtually identical” prong of the bona fide copy test. The Court denies in part the motion
20 and concludes that the first “virtually identical” prong of the bona fide copy test is not met
21 because the prototype and production wishbones are different sculptural works, created
22 nearly two years apart from different graphite electrodes and molds, with admitted resulting
23 differences.

24 Accordingly, the existing deposit materials are not sufficient to support a valid
25 copyright registration in Lucky Break’s prototype wishbone, and Lucky Break cannot
26 maintain an infringement action based on its current registration of the wishbone copyright.

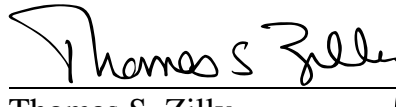
1 See 17 U.S.C. § 411(a). The Court does not have jurisdiction over Lucky Break's copyright
2 infringement claim in the prototype wishbone. The Court advises the parties that it will
3 dismiss Lucky Break's copyright infringement claim in the prototype wishbone, see Second
4 Am. Compl. ¶¶ 29-30, without prejudice, unless Lucky Break supplements its registration
5 pursuant to 17 U.S.C. § 408(d) or registers the prototype wishbone with the U.S. Copyright
6 Office within thirty days of the entry of this Order. The Court directs Lucky Break to file a
7 status report by **February 19, 2008** regarding any supplement to the current registration, or
8 new registration of, the prototype wishbone.

9 **III. Other Motions for Reconsideration**

10 The Court previously deferred its ruling on the other two pending motions for
11 reconsideration, docket nos. 147 and 150, until the Court's jurisdiction over Lucky Break's
12 copyright infringement claim based upon the prototype wishbone was resolved. Minute
13 Order of Jan. 7, 2008, docket no. 158. Because the Court has given Lucky Break thirty days
14 to supplement its registration pursuant to 17 U.S.C. § 408(d) or register the prototype
15 wishbone with the U.S. Copyright Office, the Clerk is directed to RE-NOTE the motions for
16 reconsideration, docket nos. 147 and 150, to February 19, 2008.

17 IT IS SO ORDERED.

18 DATED this 18th day of January, 2008.

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20 
21 Thomas S. Zilly
22 United States District Judge
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